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In re Application of : DECISION ON  
HARDER et al. :  
Application No.: 10/597,099 :  
PCT No.: PCT/EP2005/001167 : PAPERS  
Int. Filing Date: 04 February 2005 :  
Priority Date: 06 February 2004 : UNDER 37 CFR 1.42  
Attorney's Docket No.: 149459.00003 :  
For: IMPLANT FOR RELEASING AN ACTIVE :  
SUBSTANCE INTO A VESSEL THROUGH WHICH :  
A BODY MEDIUM FLOWS :

This is a decision on the submission filed by applicants on 11 July 2006 and on 29 November 2006, each of which was accompanied by, *inter alia*, a declaration of the inventors. The indication in these declarations that inventor Bernd Heublen is deceased has properly been treated as a request for status under 37 CFR 1.42.

This is also a decision on the “PETITION FOR CORRECTION OF INVENTORSHIP OF PATENT APPLICATION UNDER 35 U.S.C. 116 and 37 CFR 1.48(a)” filed by applicants on 29 November 2006, which has properly been treated as a petition under 37 CFR 1.497(d).

**BACKGROUND**

On 04 February 2005, applicants filed international application PCT/EP2005/001167 which claimed a priority date of 06 February 2004 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 18 August 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 07 August 2006 (06 August 2006 being a Sunday).

On 11 July 2006, applicants filed for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee, a substitute specification, a marked-up copy of the substitute specification, and a declaration of inventors. The indication in this declaration that inventor Bernd Hueblen is deceased has been treated as a request for status under 37 CFR 1.42.

On 29 November 2006, applicants filed a “PETITION FOR CORRECTION OF INVENTORSHIP OF PATENT APPLICATION UNDER 35 U.S.C. 116 and 37 CFR 1.48(a)”,

which has properly been treated as a petition under 37 CFR 1.497(d). The submission was also accompanied by a declaration of inventors. The indication in this declaration that inventor Bernd Hueblen is deceased has also been treated as a request for status under 37 CFR 1.42.

### DISCUSSION

The declaration of inventors filed 11 July 2006 is not in compliance with 37 CFR 1.497(a)-(b). 37 CFR 1.41(a)(4) states:

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. See § 1.497(d) and (f) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

The declaration filed 11 July 2006 does not list the inventorship set forth in the international application. The declaration only lists five of the six inventors listed in the international application. A Form PCT/IB/306 (NOTIFICATION OF THE RECORDING OF A CHANGE) from the International Bureau indicating that inventor Heinz Muller has been removed does not appear in the application file. Nor is there any other indication that a PCT Rule 92<sup>bis</sup> change has been made in the above-identified international application. Accordingly, the inventorship in the national stage is the inventorship set forth in the international application and the declaration filed 31 May 2006 is not sufficient.

#### Petition Under 37 CFR 1.497(d)

The petition filed 29 November 2006 requests that Heinz Muller be added as an inventor. This petition has properly been treated as a petition under 37 CFR 1.497(d). However, the petition is moot since, as noted above, Heinz Muller is already identified as an inventor in the international application (see the second page of the published document).

#### Request Under 37 CFR 1.42

The declaration filed 29 November 2006 fails to comply with 37 CFR 1.497(a)-(b). The declaration does not include the full name *and citizenship* of the deceased inventor (37 CFR 1.497(a)(3)).

#### Declaration filed 29 November 2006

The declaration filed 29 November 2006 is an improper composite declaration, consisting of one of Page 1, two of Page 2, one of Page 1 of 2, two of Page 2 of 2, and Supplemental Page. Each inventor must be presented with a complete declaration which lists all of the inventors, and the signature of each inventor must appear on at least one complete declaration. Multiple complete declarations may be submitted, but it is not permissible to combine pages of separate documents. (The declaration filed 11 July 2006 was also a composite declaration.)

Translation

Applicant has not provided a translation of the international application as filed. The submission of 11 July 2006 includes a substitute specification and a marked-up copy of the substitute specification but does not include an English translation of the application as originally filed.

CONCLUSION

For the above reasons, the petition under 37 CFR 1.497(d) is **DISMISSED** as **MOOT**.

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Applicant is required to submit a proper declaration or declarations in compliance with 37 CFR 1.497 and 1.42, an English translation of the international application as filed, and the processing fee under 37 CFR 1.492(i) for providing the translation later than thirty months from the priority date, within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."



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